

Appl. No. : 09/781,685
Filed : February 12, 2001

REMARKS

In response to the Office Action mailed August 2, 2004, Applicant respectfully requests the Examiner to reconsider the above-captioned patent application in view of the foregoing amendments and the following comments. As a result of the amendments listed above, Claims 1-24 and 26-32 remain pending. Claim 7 has been cancelled without prejudice or disclaimer, and Claims 1-3, 7, 13, 15 and 21-24 have been amended. New Claims 26-32 have been added.

In the Office Action mailed August 2, 2004, the Examiner disposed of the claims as follows:

CLAIM NOS.	DISPOSITION/REJECTION		
	BASIS	PRIMARY REFERENCE	SECONDARY REFERENCE(S)
1-25	102(e)	Snyder USP 6,038,561	n/a
7	112 ¶ 2	n/a	n/a

The Examiner also noted that Claim 25 will be objected to under 37 C.F.R. § 1.75 as a substantial duplicate of Claim 2, should Claim 2 be found allowable.

Personal Interview

Applicant thanks Examiner Adam Queler for the courteous and helpful personal interview conducted on November 4, 2004 (summarized above).

Claim 1

Claim 1 stands rejected as anticipated by Snyder. However, Applicant has amended Claim 1 to recite:

1. (CURRENTLY AMENDED) A hierarchical document cross-referencing system comprising:
 - a document server computer accessible by a user computer, said document server computer comprising:
 - a database which stores the contents of a first document and a second document wherein said first document and said second document each includes one or more segments, each of said segments having segment content and a corresponding segment label wherein said segment label is shorter than said segment content; and
 - a module executable in said document server computer wherein said module is configured to receive a request to search said first document and said

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second document for a key phrase composed and input by a user, said module searches said first document and said second document for said key phrase, said module identifying said segments containing said key phrase, said module displaying on said user computer a side-by-side display wherein said side-by-side display lists only the labels, and not the segment content, of said identified segments from said first document in a first list and lists only the labels, and not the segment content, of said identified segments from said second document in a second list.

Applicant respectfully submits that amended Claim 1 is in condition for allowance over the prior art of record, including the Snyder patent cited by the Examiner. For example, the embodiment of the Snyder system cited by the Examiner as presenting a side-by-side display (in Figure 10C) produces the output of Figure 10C only in response to a highly complex and highly specialized "patent query" discussed in column 26:33 - 27:12. In the Snyder system of Figures 10A-10C, the user is restricted to selecting one of the patents in the Snyder database for performing this "patent query." No connection is drawn in the Snyder patent between the keyword input mentioned in column 3:61-64, and the output screen shown in Figure 10C.

Moreover, the output screen of Figure 10C appears to display pairs of patent claims, each pair comprising (in the left-hand column) a claim from the patent selected by the user for comparison against the other patents in the database, and (in the right-hand column) a claim from one of the patents against which the user-selected patent was compared. The claims appear to have been paired based on their overall textual similarity. This differs substantially from displaying the "segments" from the respective documents/patents found to contain a key phrase (e.g., a word, multiple words, letter, byte, bit, pixel, pattern, image, frame, scene, etc.) input by the user.

Applicant further submits that it would not be obvious to modify the Snyder system of Figures 10A-10C to incorporate key-phrase searching as recited in Claim 1. For example, it is difficult to see how one would use a key-phrase search as claimed, to generate the output of Figure 10C, while preserving the "theme score" depicted therein and further described at col. 7:15-29. It is well established that, in the context of obviousness, "[a] proposed modification cannot render the prior art unsatisfactory for its intended purpose." See M.P.E.P. § 2143.01; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

For at least these reasons, Applicant respectfully submits that Claim 1 is in condition for allowance over the prior art of record.

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Independent Claims 3, 13 and 21-24

Independent Claims 3, 13 and 21-24 each recite a combination of features or method steps somewhat different from that recited in Claim 1. However, Claims 3, 13 and 21-24 are believed to be in condition for allowance over the prior art of record for, inter alia, reasons similar to those discussed above with respect to Claim 1.

Dependent Claims

Dependent Claims 2, 4-12 and 14-20 are also believed to be in condition for allowance, by virtue of their dependence from allowable base claims as well as their recitation of further novel and non-obvious combinations of features and/or acts.

New Claims

Applicant submits herein new Claims 26-32, which are also believed to be in condition for allowance over the prior art of record.

Claim 7

Applicant has amended Claim 7 to address the indefiniteness concerns raised by the Examiner.

Claim 25

Applicant has cancelled Claim 25 to address the Examiner's concerns under 37 C.F.R. § 1.75.

Supplemental Information Disclosure Statement

Applicant submits herewith a Supplemental Information Disclosure Statement listing additional references for consideration by the Examiner.

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Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, issuance of a Notice of Allowance is most earnestly solicited.

Applicant respectfully traverses each of the Examiner's rejections and each of the Examiner's assertions regarding what the prior art shows or teaches. Although amendments, deletions and cancellations have been made, no acquiescence or estoppel is or should be implied thereby. Rather, the amendments, deletions and cancellations are made only to expedite prosecution of the present application, and without prejudice to presentation or assertion, in the future, of claims on the subject matter affected thereby. Any arguments in support of patentability and based on a portion of a claim should not be taken as founding patentability solely on the portion in question; rather, it is the combination of features or acts recited in a claim which distinguishes it over the prior art.

The undersigned has made a good faith effort to respond to all of the rejections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney, Mark J. Kertz at (949) 721-6318 to resolve such issue(s) promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By: Mark Kertz
Mark J. Kertz
Registration No. 43,711
Attorney of Record
Customer No. 20,995
(949) 760-0404